

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-18 and 20-33 are currently pending. Claims 1, 6, 23, 24, 26, and 30 have been amended; and Claim 33 has been added by the present amendment. No new matter has been added.<sup>1</sup>

In the outstanding Office Action, Claims 1, 23, 26, and 30 were objected to as containing informalities; Claims 23-25 were rejected under 35 U.S.C. § 102(a) as being anticipated by Niitsuma et al. (U.S. Patent Application Publication No. 2001/0050782 A1, hereinafter “the ‘782 publication”); Claims 1-7, 22, 26, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘782 publication in view of Yoshida (U.S. Patent No. 6,931,432 B1, hereinafter “the ‘432 patent”); Claims 8, 31, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘782 publication in view of the ‘432 patent and Kuwahara (U.S. Patent No. 6,603,579 B1, hereinafter “the ‘579 patent”); Claims 9 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘782 publication in view of the ‘432 patent and Suzue (U.S. Patent No. 6,618,166 B1, hereinafter “the ‘166 patent”); Claims 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘782 publication in view of the ‘432 patent, the ‘166 patent, and Toda (U.S. Patent No. 6,256,107 B1, hereinafter “the ‘107 patent”); Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘782 publication in view of the ‘432 patent and Huttenlocher et al. (U.S. Patent No. 6,011,905, hereinafter “the ‘905 patent”); Claims 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘782 publication in view of the ‘432 patent and the ‘107 patent; and Claim 18 was rejected under 35 U.S.C.

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<sup>1</sup> The amendments to Claims 1, 23, 26, and 30 find support at least in Figure 28 and its accompanying text in the specification.

§ 103(a) as being unpatentable over the ‘782 publication in view of the ‘432 patent, the ‘107 patent, and the ‘905 patent.

In light of the several grounds for rejection, Claims 1, 23, 26, and 30 have been amended to address the informalities noted in the Office Action. Further, Applicants submit that “the format of the image data” clearly finds antecedent basis in the term “a format of image data,” and not in the term “a transfer-time format.” Consequently, the outstanding grounds of objection are believed to be overcome, without the addition of new matter.

Independent Claim 23 stands rejected as anticipated by the ‘782 publication. Amended Claim 23 recites an image-forming apparatus, including, in part, “an image data conversion part configured to convert image data received from the connected apparatus . . . , the format of the received image data . . . being inversely convertible in the image-forming apparatus, when the format of the received image data cannot be output by the image-forming apparatus.” Applicants submit that the ‘782 publication fails to disclose these features.

According to the ‘782 publication,

In the apparatus of the transferring point, when the apparatus itself has an extension function to extend the compressed image data, the apparatus directs to compress the image data and transfer it, and when it does not have, the apparatus directs to not compress the image data and transfer it.<sup>2</sup>

That is, the ‘782 publication merely discloses that the apparatus of the transferring point directs whether it can extend compressed image data. Applicants submit that the ‘782 publication is silent regarding “an image data conversion part configured to convert image data received from the connected apparatus . . . , the format of the received image data . . . being inversely convertible in the image-forming apparatus, when the format of the received image data cannot be output by the image-forming apparatus,” as recited in amended

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<sup>2</sup> ‘782 publication, para. [0117].

Claim 23. Accordingly, it is respectfully submitted that independent Claim 23 (and all associated dependent claims) patentably defines over the ‘782 publication.

Independent Claims 1, 26, and 30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the ‘782 publication in view the ‘432 patent.

Amended Claim 1 recites an image-forming apparatus, including, in part, “a format determination part . . . configured to determine the transfer-time format based on whether the format of the image data is inversely convertible in the connected apparatus, when the format of the image data cannot be output in the connected apparatus . . .” Applicants respectfully submit that the ‘782 publication and the ‘432 patent fail to disclose or suggest these features.

The ‘782 publication, states “[i]n the compression selection means of the digital copier 1, according to this direction, it is selected and determined whether the image data is compressed and transmitted, or the image data is not compressed and transmitted.”<sup>3</sup> That is, the ‘782 publication merely discloses that a digital copier determines whether image data is compressed. Applicants respectfully submit that the ‘782 publication is silent with regard to a format determination part . . . configured to determine the transfer-time format based on whether the format of the image data is inversely convertible in the connected apparatus, when the format of the image data cannot be output in the connected apparatus,” as recited in amended Claim 1.

The Office Action does not rely on the ‘432 patent as teaching Applicants’ claimed “format determination part.” Further, it is submitted that the ‘432 patent does not disclose or suggest the “format determination part” recited in amended Claim 1.

Thus, the ‘782 publication and the ‘432 patent fail to disclose or suggest “a format determination part,” as recited in amended Claim 1. Accordingly, it is submitted that

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<sup>3</sup> Id.

independent Claim 1 (and all associated dependent claims) patentably defines over any proper combination of the '782 publication and the '432 patent.

It is further submitted that independent Claims 26 and 30 also define over the '782 publication and the '432 patent for the same reasons as discussed above with regard to Claim 1 and for the more detailed features presented in these claims.

Accordingly, from the above discussion, it is respectfully submitted that the several grounds for rejection have either been rendered moot or overcome by the present amendment. Withdrawal of these grounds for rejection is therefore believed to be in order and is respectfully requested.

New Claim 33 has been added to set forth the claimed invention in a varying scope. Applicants respectfully submit the new claim at least finds support in Figure 28 and its accompanying text in the specification. No new matter has been added. Accordingly, it is respectfully submitted that dependent Claim 33 is allowable for the same reasons as discussed above with regard to Claim 1, from which Claim 33 depends, and for the more detailed features presented by the new claim.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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